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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590 Medicus Associates 4025 Arbor Rd. Joplin, MO 64804				
EXAMINER				
COONEY, JOHN M				
ART UNIT		PAPER NUMBER		
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06/16/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/811,248

Applicant(s)

PARK ET AL.

Examiner

John Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 56-61 and 63-74 is/are pending in the application.
- 4a) Of the above claim(s) 64-73 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 56-61, 63 and 74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-19-08 has been entered.

Specification

The amendment filed 5-19-08 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The incorporated disclosure of materials and embodiments of the instant invention lacks support or incorporation by reference in the instant originally filed supporting disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 56-61, 63, and 74 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' amendments to the claims that were received 5-3-07 are directed towards elements and features that were not contained in the originally filed supporting disclosure in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

The following arguments are maintained:

Applicants' arguments and the record as a whole have been considered. However, applicants' originally filed supporting disclosure does not "incorporate by reference" the disclosure of the 08/416,269 application and the evidence of record is not clear that the amendments are directed towards inadvertently omitted subject matter allowed for under 37 CFR 1.57(a).

Additionally, applicants should not 37 CFR 1.57(a)(3) wherein it is stated that: (3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f).

Applicants' arguments have been considered. However, rejection is maintained. It is not agreed that the conditions of 37 CFR 1.57(b) have been properly met. It is maintained that incorporation needs to be made by way of petition in accordance with 37 CFR 1.57(a).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 56-61,63 and 74 are rejected under 35 U.S.C. 102(a) as being anticipated by DE-195 40 951 (corresponding to USPAT 6,136,873)(Hereon referred to as HAHNLE et al.).

HAHNLE et al. disclose preparations of superabsorbent polymeric hydrogel composite materials prepared by combining under polymerization conditions ethylenically-unsaturated monomers as claimed, multi-olefinic crosslinking materials,

and other fillers, additives and agents in amounts as claimed reading on the materials of applicants' claims (See HAHNLE et al. in its entirety). [– Note also – the following cites from USPAT 6,136,873 {for informational purposes only} pertaining to English language recitations of the later US equivalent – abstract, column 1 lines 12-16, column 2 line 24 et seq., column 3, column 5 line 26 et seq., column 6 lines 1-9, column 8 lines 49 et seq., column 9 lines 1-30, column 10-13, column 14 lines 1-6, and the examples -]. HAHNLE et al. discloses the carbonate compounds of applicants' claims to a degree that anticipation is evident {see column 2 lines 5-7, column 3 lines 24-32, and column 5 lines 14-18 of the English language 6,136,873 supporting document}. Although swelling ratio values and compression values are not particularly disclosed by HAHNLE et al., it is held, given the make-ups and disclosed properties and behaviors of the materials disclosed, that these features of the claims are inherently possessed by the articles disclosed.

Applicants' arguments have been considered. However, rejection is maintained for the reasons set forth above.

The following remarks are maintained from previous Office actions:

Applicants' inserted carbonate blowing agent is noted and addressed in the rejection above. The inherent gas forming effect arising from the presence of these compounds is recognized by the teachings of HAHNLE et al.

Applicants' affidavit evidence has been considered but rejection is not overcome. The affidavit filed on 7-24-06 under 37 CFR 1.131 has been considered but is ineffective to overcome the cited HAHNLE et al. reference.

The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the cited HAHNLE et al. reference. When considering the facts and documentary evidence in support of applicants' affidavit, it is necessary that the

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showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained. {see also MPEP 715.07 for Facts and Documentary Evidence general requirement}. Applicants have not met the requirements of MPEP 715, and rejection is maintained.

Regarding applicants' claim of priority, though not addressed in applicants' arguments pertaining to this rejections, it is noted that if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 USC 112 in the parent non-provisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application {See M.P.E.P. 211.11 VI}. Such is the case here. The 5,750,585 patent does not adequately disclose the broadly or specifically defined subject matter of the claims of the instant invention, including at least the ranges of pore size values and other quantitative and physical elements of the claims instant materials of the instant claims. The disclosure of 5,750,585 is not seen to adequately disclose the invention of the instant claims.

It is maintained that applicants have not adequately established that the claims of this application are afforded the effective filing date of the indicated 08/416,269 application.

Support for the incorporation the submitted subject matter from the 08/416,269 application from which this application is now a Continuation-in-Part application is not evident. It is maintained that this application is not afforded the effective filing date in overcoming the art of record

Claims 56-61,63 and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Phan et al.(5,506,035).

Van Phan et al. disclose preparations of superabsorbent crosslinked composite polymer materials as claimed by applicants which are insoluble in water but swell to an equilibrium size in the presence of excess water {hydrogel} and are prepared by combining under polymerization conditions ethylenically-unsaturated monomers as claimed, multi-olefinic crosslinking materials, and other fillers, additives, and agents in amounts as claimed reading on the materials of applicants' claims (See the abstract, column 6 line 34 et seq., column 7, column 8 lines 1-53, and column 10 lines 35-60, as well as, the entire document). Van Phan et al. discloses the carbonate compounds of applicants' claims to a degree that anticipation is evident {see column 2 lines 49-54, column 5 lines 19-39, and column 11 lines 7-43}. Although swelling ratio values, and compression values are not particularly disclosed by Van Phan et al., it is held, given the make-ups and disclosed properties and behaviors of the materials disclosed, that these features of the claims are inherently possessed by the articles disclosed.

Applicants' arguments have been considered. However, rejection is maintained for the reasons set forth above.

The following remarks are maintained from previous Office actions:

Applicants' inserted carbonate blowing agent is noted and addressed in the rejection above. The broadly disclosed invention is seen to encompass and readily envision the carbonate blowing agents specifically identified as blowing agents by the disclosure of Van Phan et al.

Regarding applicants' claim of priority, it is noted that if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 USC 112 in the parent non-provisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application {See M.P.E.P. 211.11 VI}. Such is the case here. The 5,750,585 patent does not adequately disclose the broadly or specifically defined subject matter of the claims of the instant invention, including at least the ranges of pore size values and other quantitative and physical elements of the claims and materials of the instant claims. The disclosure of 5,750,585 is not seen to adequately disclose the invention of the instant claims.

It is maintained that applicants have not adequately established that the claims of this application are afforded the effective filing date of the indicated 08/416,269 application.

Support for the incorporation the submitted subject matter from the 08/416,269 application from which this application is now a Continuation-in-Part application is not evident. It is maintained that this application is not afforded the effective filing date in overcoming the art of record.

Claims 56-61,63 and 74 are rejected under 35 U.S.C. 102(b) as being anticipated by Park et al.(Society for Biomaterials article).

Park et al. discloses hydrogel foam compositions comprising polymers prepared from ethylenically-unsaturated monomers as claimed and multiolefinic crosslinking agents (see the entire document). Although swelling ratio values, and compression values are not particularly disclosed by Park et al., it is held, given the make-ups and disclosed properties and behaviors of the materials disclosed, that these features of the

claims are inherently possessed by the articles disclosed. Though amounts of proportions of monomer and crosslinking agent are not specified by Park et al. it is held that the widely encompassing range of values for this multifunctional co-reactant is readily envisaged from the teachings of the disclosed Park et al. reference. Additionally, inclusion of fillers for bulking purposes is a modification readily envisioned from within the teachings of Park et al.

The following previous arguments are maintained:

Applicants' arguments pertaining to this rejection have been considered but rejection is maintained for all of the reasons set forth above. Examiner holds that the evidence of record based on the materials disclosed and their properties and behaviors supports the currently held position of anticipation as the reference discloses materials prepared from materials of applicants' claims and no differences in work-ups are seen which would lead to pore sizes outside of the encompassing range of values expressed by applicants' claims.

The points of law cited in applicants' most recent response relate to a different fact situation than that present in the instant case. Applicants have not demonstrated differences based on the materials employed in the making of the articles of their claims or based on the manner which they are prepared which serve to establish failure of the instantly held rejection.

Regarding applicants' claim of priority, it is noted that if a claim in a continuation-in-part application recites a feature which was not disclosed or adequately supported by a proper disclosure under 35 USC 112 in the parent non-provisional application, but which was first introduced or adequately supported in the continuation-in-part application such a claim is entitled only to the filing date of the continuation-in-part application (See M.P.E.P. 211.11 VI). Such is the case here. The 5,750,585 patent does not adequately disclose the broadly or specifically defined subject matter of the claims of the instant invention, including at least the ranges of pore size values and other quantitative and physical elements of the claims and materials of the instant claims. The disclosure of 5,750,585 is not seen to adequately disclose the invention of the instant claims. Applicants' argue support to be evident in, at least, examples 2-7 of 5,750,585. However, this support is not seen, and this support has not been shown.

Applicants' latest arguments have been considered. However, rejection is maintained for the reasons set forth above.

It is maintained that applicants have not adequately established that the claims of this application are afforded the effective filing date of the indicated 08/416,269 application.

Support for the incorporation the submitted subject matter from the 08/416,269 application from which this application is now a Continuation-in-Part application is not evident. It is maintained that this application is not afforded the effective filing date in overcoming the art of record

Claims 56-61,63 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by EP-0,744,435.

EP-0,744,435 disclose preparations of superabsorbent crosslinked hydrogel composite polymer materials which are insoluble in water but swell to an equilibrium size in the presence of excess water {hydrogel} and are prepared by combining under polymerization conditions ethylenically-unsaturated monomers as claimed, multi-olefinic crosslinking materials, and other fillers, additives and agents, including inorganic carbonate blowing agent materials, reading on the materials of applicants' claims (See the abstract, page 8 line 57-page 9 line 26, page 10 lines 37-42, page 10 line 47 - page 14 line 7, page 20 line 1, and example 5, as well as, all of the examples and the entire document).

As the record currently stands, applicants' reference to the materials of their claims as being an interpenetrating network is not distinguishing of the claims in a patentable sense. The materials employed in the making of the products of EP-0,744,435 and the process by which they are formed are so similar to the materials and processes of applicants' claims that the formation of an interpenetrating network to the degree defined by applicants' claims is held to be inherent to the teachings of EP - 0,744,435.

Applicants' latest arguments have been considered. However, rejection is maintained for the reasons set forth above.

It is maintained that applicants have not adequately established that the claims of this application are afforded the effective filing date of the indicated 08/416,269 application.

Support for the incorporation the submitted subject matter from the 08/416,269 application from which this application is now a Continuation-in-Part application is not evident. It is maintained that this application is not afforded the effective filing date in overcoming the art of record

Statement of the rejection has been corrected to indicate that rejection is under 35 USC 102(e).

If applicants wish to arrange for an interview, they may do so at their earliest convenience.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796